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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/882,197	06/25/97	GREER	P 42390.P4072

TM11/0410
BLAKELY SOKOLOFF TAYLOR & ZAFMAN
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EXAMINER	
MEINECKE DIAZ,S	
ART UNIT	**PAPER NUMBER**
2163	23

DATE MAILED: 04/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/882,197	06/25/97	GREER	P 42390.P4072

TM02/0328
BLAKELY SOKOLOFF TAYLOR & ZAFMAN
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EXAMINER	
MEINECKE DIAZ,S	
ART UNIT	**PAPER NUMBER**
2163	

DATE MAILED: 03/28/01

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Commissioner of Patents and Trademarks

PTO-90C (Rev. 2/95)
*U.S. GPO: 2000-473-000/44602

1- File Copy

Office Action Summary

Application No.	Applicant(s)
08/882,197	Greer et al.
Examiner	**Group Art Unit**
Susanna Meinecke-Díaz	2163

☒ Responsive to communication(s) filed on *Dec 28, 2000*.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-14 and 16-45* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-14 and 16-45* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Continued Prosecution Application

1. The request filed on December 28, 2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) is acceptable and a CPA has been established. An action on the CPA follows.

Claims 1-14 and 16-45 are pending.

2. The Examiner thanks the Applicant for clarifying some of the explanation found in the specification.

The previous claim objection is withdrawn.

The previous 112 rejections are withdrawn.

3. The Examiner has considered the Applicant's preliminary amendment. While only minimal changes were made to the claims in the after final amendment, such changes altered the scope slightly and were therefore denied entry after final. For example, the scope of claim 7 was narrowed by limiting the transmission of content from the database to the target computer (i.e., the content could have been transmitted anywhere before the claim amendment).

Response to Arguments

4. Applicant's arguments filed December 28, 2000 have been fully considered but they are not persuasive. Furthermore, Applicant's arguments with respect to the art rejection of claims 1-14 and 16-45 have been considered but are moot in view of the new ground(s) of rejection.

Regarding the Applicant's arguments in response to the 101 rejection, the Examiner asserts that "to be transmitted" conveys a future transmission. As such, it is not clear whether or not the bounds of the Applicant's invention are meant to incorporate the actually transmission of the content from a database to the target computer. The Applicant merely needs to change the "to be transmitted" language to "transmitted" in order to clarify that the transmission of content is a positive recitation. This wording change would overcome the 101 rejection.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 14, 16-20, 23, 27, 32, 40, 42, and 45 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

While claims 14, 16-20, 23, 27, 32, 40, 42, and 45 are limited to the technological arts (e.g., they are limited to a computer environment), claims 14, 16-20, 23, 27, 32, 40, 42, and 45 are deemed non-statutory for failing to recite a practical application within the technological arts.

It is not clear from the claim language what practical purpose(s) claims 14, 16-20, 23, 27, 32, 40, 42, and 45 set out to achieve.

The Examiner does recall her interview with the Applicant's representative; however, she does not recall telling the Applicant's representative that claim 14 is statutory. As a matter of fact, the Examiner recorded in her notes that claims 14 and 15 were still non-statutory while claims 1 and 7 would be deemed statutory since they actually carry out a transmission of data. Claim 14 still recites a future transmission of data (i.e., it is not clear whether or not the transmission is actually carried out). Also, please note that claim 22 (which is dependent from claim 14) has been deemed statutory since it positively recites the transmission of data.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-14 and 16-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 14, 16-20, 23, 27, 32, 40, 42, and 45: As discussed above, claims 14, 16-20, 23, 27, 32, 40, 42, and 45 recite the future transmission of content from a database to the target computer

(e.g., "to be transmitted" language). It is not clear whether the bounds of the Applicant's invention are meant to incorporate the actual transmission of said content or not. Please clarify. Claims 1-14 and 16-45: It is unclear how a rulebook per se generates a rule. A user may store rules in the rulebook, but the rulebook itself could not generate rules. Instead, it may execute functions based on particular rules. Please clarify what is meant by the generation of a rule by the rulebook. For examination purposes, the Examiner understands the rulebook to reference the most appropriate rule regarding information to be gathered concerning a user.

ART REJECTION #1

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

10. Claims 1, 2, 5-8, 12-14, 16, 21, 22, 27, 29-31, and 38-45 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Dedrick (U.S. Patent No. 5,710,884).

As in the claimed invention, Dedrick teaches the use of agents to proactively target users with advertisements that would likely be of interest to the users (as judged based on the user's updated profile). See at least col. 9, lines 3-46. It should also be noted that condition-action pair

rules are inherent for the targeting of advertisements to occur. For example, such rules must incorporate logic along the lines of, "If user A has characteristic X, then send user A advertisement B." This is an example of a condition-action pair rule.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claims 3, 4, 9-11, 17-20, 23-26, 28, and 32-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick (U.S. Patent No. 5,710,884), as applied to claims 1, 2, 5-8, 12-14, 16, 21, 22, 27, 29-31, and 38-45 above.

While Dedrick discloses the targeting of different information based on various rules applied to a user's profile, Dedrick does not explicitly outline every rule permutation possible. Claims 3, 4, 9-11, 17-20, 23-25, 28, and 32-34 and 37 merely address the characteristics of the target computer. Artisans of ordinary skill in the art have long known that it is common to collect data regarding a computer user's hardware and software in order to gather information about a computer user's hardware and software interests as well as to assist in establishing effective computer communications. For example, certain network protocols may need to be established for data transmission depending on a user's particular computer characteristics, including memory

usage, memory available, processor clock speed, operating system, modem speed, software, etc. As a matter of fact, a user's Internet and/or general networking capabilities are dependent on each of these factors; therefore, certain software may not even be compatible with the user's computer system. As a result, it would be a waste of time to attempt to download or even market products that are incompatible with a user's computer system to that particular user. Consequently, it would behoove an agent to be programmed to retrieve data regarding said hardware and software characteristics in order to effectively assess which information is to be targeted to which users, thereby making such an enhancement to Dedrick's invention obvious to one of ordinary skill in the art at the time of Applicant's invention.

As per claims 26, 35, and 36, while Dedrick gathers information concerning web sites visited by a user, he does not explicitly disclose that he records the time spent by the user at each web site; however, the Examiner asserts that such a limitation would be deemed obvious in light of the fact that artisans of ordinary skill in the art have long been aware of the correlation between a user's interest in a given topic and the time the user spends researching that topic. Therefore, the longer a user spends at a given web site, the more interest the user likely has in the information related with that particular web site. Consequently, an artisan of ordinary skill in the art at the time of Applicant's invention would have found it obvious to not only record information concerning the web sites visited by a user, but also to record the time spent at each web site in order to enable more effective targeting of information to a user based on a more accurate analysis of that user's interests.

ART REJECTION #2

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

14. Claims 1, 2, 5-8, 12-14, 16, 21, 22, 27, 30, 31, and 39-43 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Davies et al. (WO 96/23265).

As in the claimed invention, Davies teaches the use of agents to proactively target users with information that would likely be of interest to the users (as judged based on the user's updated profile). See at least page 5, lines 11-28; page 6, lines 8-18; page 8, lines 7-10; page 9, lines 5-10, 27-30; page 10, lines 20-26; page 11, lines 1-17. It should also be noted that condition-action pair rules are inherent for the targeting of information to occur. For example, such rules must incorporate logic along the lines of, "If user A has characteristic X, then send user A information B." This is an example of a condition-action pair rule.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

16. Claims 3, 4, 9-11, 17-20, 23-26, 28, 29, 32-38, 44, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davies et al. (WO 96/23265), as applied to claims 1, 2, 5-8, 12-14, 16, 21, 22, 27, 30, 31, and 39-43 above.

While Davies discloses the targeting of different information based on various rules applied to a user's profile, Davies does not explicitly outline every rule permutation possible. Claims 3, 4, 9-11, 17-20, 23-25, 28, and 32-34 and 37 merely address the characteristics of the target computer. Artisans of ordinary skill in the art have long known that it is common to collect data regarding a computer user's hardware and software in order to gather information about a computer user's hardware and software interests as well as to assist in establishing effective computer communications. For example, certain network protocols may need to be established for data transmission depending on a user's particular computer characteristics, including memory usage, memory available, processor clock speed, operating system, modem speed, software, etc. As a matter of fact, a user's Internet and/or general networking capabilities are dependent on each of these factors; therefore, certain software may not even be compatible with the user's computer system. As a result, it would be a waste of time to attempt to download or even market products that are incompatible with a user's computer system to that particular user. Consequently, it would behoove an agent to be programmed to retrieve data regarding said hardware and software characteristics in order to effectively assess which information is to be targeted to which users,

thereby making such an enhancement to Davies' invention obvious to one of ordinary skill in the art at the time of Applicant's invention.

As per claims 26, 35, and 36, while Davies gathers information concerning web sites visited by a user, he does not explicitly disclose that he records the time spent by the user at each web site; however, the Examiner asserts that such a limitation would be deemed obvious in light of the fact that artisans of ordinary skill in the art have long been aware of the correlation between a user's interest in a given topic and the time the user spends researching that topic. Therefore, the longer a user spends at a given web site, the more interest the user likely has in the information related with that particular web site. Consequently, an artisan of ordinary skill in the art at the time of Applicant's invention would have found it obvious to not only record information concerning the web sites visited by a user, but also to record the time spent at each web site in order to enable more effective targeting of information to a user based on a more accurate analysis of that user's interests.

As per claims 29, 38, 44, and 45, Davies does not explicitly state that the information targeted to a user is an advertisement per se; however, the fact that Davies' agents make users aware of information of interest could be broadly construed as an advertisement. An advertisement in its broadest reasonable interpretation is an announcement. Furthermore, artisans of ordinary skill in the art have long known of the practice of targeting advertisements (e.g., in the marketing sense) to the particular audience most likely to be responsive to said advertisements in order to concentrate a sponsor's marketing effort, which maximizes profit while minimizing

advertising expense. An artisan of ordinary skill in the art at the time of Applicant's invention would have found it obvious to target advertisements to Davies' users in order to effectively send advertisements to those users who are most likely to be interested in the products and/or services being promoted, thereby maximizing profit while minimizing advertising expense.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Davies et al. (U.S. Patent No. 5,931,907) -- The U.S. equivalent of World Patent WO 96/23265 applied in Art Rejection #2 above.

Herz et al. (U.S. Patent No. 5,754,939) -- Discloses the customization of electronic information based on a "target profile."

Herz et al. (U.S. Patent No. 5,754,938) -- Discloses the customization of electronic information based on a "target profile."

Dedrick (U.S. Patent No. 5,717,923) -- Discloses the customization of electronic information based on an individual end user's profile.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna Meinecke-Díaz whose telephone number is (703) 305-1337. The examiner can normally be reached Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at (703) 305-9643.

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 305-0040.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

SMD
March 26, 2001

ERIC W. STAMBER
PRIMARY EXAMINER

FAX

UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office
Assistant Secretary and Commissioner of Patents and Trademarks
Washington, DC 20231

Date April 5, 2001

Number of pages including cover sheet 15 SMD

To:

Nancy

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CC:

From:

Susie Draz

Phone 703-305-1337

Fax Phone 703-308-1396

REMARKS:

☐ Urgent ☒ For your review ☐ Reply ASAP ☐ Please comment

Re: 08/882,197 (office action & notice of references cited)

This transmission is confidential. If received in error, please contact Susie Draz on (703) 305-1337. Thank you.